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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,626	07/28/2003	Steven M.H. Wallman	10392/460043	4309

7590 11/12/2009  
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Washington, DC 20005

EXAMINER
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GREENE, DANIEL LAWSON

ART UNIT	PAPER NUMBER
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3694

MAIL DATE	DELIVERY MODE
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11/12/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/627,626	<b>Applicant(s)</b> WALLMAN, STEVEN M.H.	
	<b>Examiner</b> DANIEL L. GREENE JR.	<b>Art Unit</b> 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 7/27/2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/31/09, 3/31/09, 11/14/07</u>                                | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's 6/19/2009 response to the previous Office action mailed 4/2/2009 has been considered and entered. Claims 1 and 2 are pending and have been examined on the merits as set forth below.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/27/2009 has been entered.

#### ***Information Disclosure Statement***

3. The two information disclosure statement's (IDS) submitted on 3/31/2009 have been considered and are attached to the instant Office action.

4. The information disclosure statement (IDS) submitted on 11/14/2007 has been considered (including reference #7) and is also attached to the instant Office action.

#### ***Response to Arguments***

5. Applicant's arguments filed 6/19/2009 have been fully considered but they are not persuasive.

#### **Applicant argues on page 4:**

“In order to advance prosecution, Applicant has amended independent claim 1 to further define the claimed invention. In particular, claim 1 recites a portfolio of

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market tradable investments to be directly owned by the investor. Maggioncalda does not teach or suggest a portfolio of market tradable investments directly owned by the investor. To the contrary, the financial products in Maggioncalda (col 10:20-30) are mutual funds, which (a) are not market tradable assets, but rather shares in a fund that must be purchased from or redeemed with the mutual fund provider (and not from a market); and (b) do not permit the user to directly own the underlying shares of any market tradable securities, etc. that are actually held by the fund. Accordingly, as Maggioncalda teaches away from the claimed invention, Maggioncalda does not, alone or in consideration of case law, render the claimed invention obvious.” (Emphasis in original)

**Response:**

As explained in, for example, sections 3 and 4 the previous Office action mailed 4/2/2009,

“Maggioncalda et al. clearly sets forth in, for example, Figures 4-5 a risk-return pointer, as well as various assets, see for example Figure 5a. Col. 10 lines 20-30 disclose, for example, various financial products. It is considered that the products listed therein can be understood to read on a "portfolio" in that a fund or index is actually based on a portfolio of assets. Accordingly, trading one share of these mutual funds is the same as trading a portfolio.

Further, as set forth in said previous Office action, it is the Examiners position that the act of trading an entire portfolio would logically flow from trading individual stocks within a single portfolio. This is evident in the fact that the end result of either method is the same, i.e. a rebalanced portfolio at the desired risk level. Again, per case law and logical reasoning, one would be motivated to combine repetitive tasks into one task for the purpose of saving time, ease or processing, etc.”

The following case law citations are pertinent to show that the references of record, e.g. Maggioncalda et al., etc., can be relied upon for what they reasonably confer to one of ordinary skill in the art.

In re Shepard, 138 USPQ 148 (CCPA 1963)

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“In considering disclosure of reference patent, it is pertinent to point out not only specific teachings of patent but also the reasonable inferences which one skilled in the art would logically draw therefrom.”

In re Fout, 213 USPQ 532 (CCPA 1982), In re Siebentritt, 152 USPQ 618 (CCPA 1967)

“Express suggestion to substitute one equivalent technique for another need not be present to render such substitution obvious”

In re Bozek, 163 USPQ 545 (CCPA 1969)

“Reference disclosure must be evaluated for all that it fairly suggests and not only for what is indicated as preferred”

In re Gurley, 31 USPQ2d 1130 (Fed. Cir. 1994)

“[A] reference will teach away if it suggests that the line of development flowing from the reference's disclosures is unlikely to be productive of the result sought by the applicant”

Here again, Maggioncalda et al. clearly discloses using a risk-return pointer and selecting a desired risk level and then performing the appropriate functions to effectuate the transactions required to satisfy the users selection. Trading one share of a mutual fund is akin to trading a portfolio containing each of the underlying securities of the fund.

The new limitation to claim 1 “market tradable...to be directly owned by an investor” are not considered as defining over the art of record because, for example, when a user purchases a share of the mutual fund, then it becomes directly owned by the investor and is obviously market tradable because that’s how the fund was able to be purchased in the first place.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 103***

**7. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maggioncalda et al. in view of either case law or Young ('409) for the reasons set forth in section 7 of the previous office action mailed 7/9/2008.**

See the discussion of this topic in section 3 above wherein it is understood that Mutual funds are considered a portfolio, each mutual fund has an inherent risk and the act of trading a mutual fund satisfies the claimed limitations.

***Conclusion***

8. The Examiner appreciates Applicant's desire to advance prosecution of the instant application. In that regard, Applicant is invited to contact the Examiner telephonically at the number listed below to discuss the instant Office action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL L. GREENE JR. whose telephone number is (571)272-6876. The examiner can normally be reached on Mon-Thur.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. L. G./

Examiner, Art Unit 3694

2009-11-09

/James P Trammell/

Supervisory Patent Examiner, Art Unit 3694